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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,420	01/18/2002	Peter Brune	0745/65813/NHZ.	3904

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EXAMINER

PEREZ, JULIO R

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,420

Applicant(s)

BRUNE ET AL.

Examiner

Julio R Perez

Art Unit

2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Owens et al. (6338140).

Regarding claim 1, Owens et al. disclose a method for distributing keys to subscribers in digital mobile radio networks, comprising the steps of: generating the keys in a security device provided at the mobile radio network end (col. 3, lines 35-49; col. 7, lines 46-63; col. 13, lines 16-61; col. 16, lines 35-56; figs. 8-9, the RPA provides authentication means for the mobile to be able to connect to the network system); requesting at least one key from the security device (col. 16, lines 35-67); and transmitting the at least one key via the mobile radio network to a mobile station terminal of a subscriber, wherein the generated keys are stored in the security device prior to transmission (col. 3, lines 35-49; col. 7, lines 46-63; col. 13, lines 16-61; col. 16, lines 35-56; figs. 8-9, keys are transmitted prior to providing services); the requesting step is performed by the subscriber (col. 3, lines 35-49; col. 7, lines 46-63; col. 13, lines 16-61; col. 16, lines 35-56; figs. 8-9, the subscriber requesting services must be pre-

Art Unit: 2681

authorized in order to acquire the system); the transmitted key is allocated to the subscriber (col. 3, lines 35-49; col. 7, lines 46-63; col. 13, lines 16-61; col. 16, lines 35-56; figs. 8-9); and the transmitted key is stored in the terminal and/or in a subscriber identity module (SIM) in the mobile station (col. 3, lines 35-49; col. 7, lines 46-63; col. 13, lines 16-61; col. 16, lines 35-56; figs. 8-9, the SIM is a storage secret keys).

Regarding claim 2, Owens et al. disclose a SIM application toolkit (SAT) application set up in the SIM in the mobile station, wherein the SAT application carries out additional end-to-end encryption of the key transmitted between the mobile station and the security device (col. 3, lines 25-49; further, it is inherent as evidenced by the fact that one of ordinary skill in the art would have recognized that GSM SIM cards contain all the information about the end user. This personal information allows security-related functions and identity verification to be carried out, which is essential for secure electronic commerce, and which is supported by many mobile operators who are providing SIM Tool Kit application over their network for customers).

Regarding claim 3, Owens et al. disclose wherein before using the SAT application, the subscriber is identified to the SIM by entering a personal identification number (PIN) (col. 7, lines 32-45).

Regarding claim 4, Owens et al. disclose wherein the transmitted key is stored in a protected memory area in the SIM (col. 9, lines 27-54; col. 10, lines 10, lines 39-64).

Regarding claim 5, Owens et al. disclose the method wherein the key is transmitted via a traffic channel in the mobile radio network (col. 9, lines 27-54; col. 10, lines 10, lines 39-64, the encryption is canalized through the network system).

Regarding claim 6, Owens et al. disclose wherein the key is transmitted in the form short message GM (SM) via a signaling channel in the mobile radio network (col. 19, lines 8-21, the system is capable of transmitting keywords via short messages).

Regarding claim 7, Owens et al. disclose wherein when the key is requested, the subscriber's authorization is checked by evaluating a mobile subscriber telephone number (MSISDN) for the subscriber (col. 13, lines 24-61, the mobile number and serial number of the terminal are verified before accessing the system).

Regarding claim 8, Owens et al. disclose wherein the security device sends the key, which is, transmitted to the subscriber to one or more added value service nodes (col. 3, lines 35-49; col. 7, lines 46-63; col. 13, lines 16-61; col. 16, lines 35-56; figs. 8-9, keys are transmitted prior to providing services, to different providers prior to providing services).

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julio R Perez whose telephone number is (703) 305-8637. The examiner can normally be reached on 7:00 - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on 703-308-4825. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2681

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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12/27/04

